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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,287	10/31/2003	Dennis Albert Doidge	RAL919970043US4	1617

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EXAMINER

HO, DUC CHI

ART UNIT PAPER NUMBER

2665

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/698,287

Applicant(s)

DOIDGE ET AL.

Examiner

Duc C Ho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26 and 34-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26 and 34-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 26, and 34-36 are rejected under 35 U.S.C. 112, first paragraph because the specification, while being enabling for a “a protocol adaptation apparatus” known to the inventor, does not reasonably provide an enablement for the “a protocol adaptation apparatus” recited in claim 26. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to the “a protocol adaptation apparatus” the invention commensurate with these claims.

As recited in claim 26, the single means “comprised only of hardware for converting and forwarding frames having a first protocol to frames having a second protocol” does not appear in combination with another recited element of means, is subjected to an undue breadth rejection under 35 U.S.C. 112, first paragraph (2164.08(a)). In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 35-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 35, it appears to Examiner that the “claimed protocol adaptation apparatus” converting one protocol to an ATM protocol locates at the ATM port 60-fig. 3, where a LAN/switch protocol is converted to an ATM protocol. It is unclear as to what is intended to be the claim limitation by reciting “the first protocol is a protocol selected from the group of ATM protocol and LAN protocol and the second protocol is a switch protocol”. The same remark applies to claim 36 for the claimed recitation “ the first protocol is a switch protocol and the second protocol is a protocol selected from the group of ATM protocol and LAN protocol”.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102(e) that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 26, and 34-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Iidaka et al. (US 5,528,590), hereinafter referred as Iidaka.

Regarding claim 26, Iidaka discloses ATM-UNI-LAN communication method and apparatus.

a protocol adaptation apparatus (the adaptation apparatus 54-fig. 1, see col. 3-line 44 to col. 4-line 62) *comprised only of hardware for converting and forwarding frames having a first protocol to frames having a second protocol, said conversion without requiring processor intervention* (the apparatus 54-fig. 1 performs converting ATM cell protocol to Frame protocol and forwarding converted frame by the data transmitter 52-fig. 1 without a processor intervention).

Regarding claim 34, the apparatus 54-fig. 1 inherently includes a table for assisting the conversion and forwarding of frames.

Regarding claim 35, the switch 60 operates with an ATM protocol (second protocol), and the first protocol via the LAN I/F 50-fig. 1 is either LAN protocol or ATM protocol.

Regarding claim 36, the switch 60 operates with an ATM protocol (first protocol), and the second protocol via the LAN I/F 50-fig. 1 is either LAN protocol or ATM protocol.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Verbesselt et al.(US 6,771,658); Katsube et al.(US 6,341,127); Allan et al. (US 5,946,313); Nogami et al. (US 6,781,994) are cited to show a method and apparatus for hardware forwarding of LANs frames over ATM networks, which is considered pertinent to the claimed invention.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Friday from 7:00 am to 3:30 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

Duc Ho

09-24-04

A handwritten signature in black ink, appearing to read 'Duc Ho', with a long horizontal flourish extending to the right.